

The Examiner has the initial burden of presenting a prima facie case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To meet this burden, the Examiner must show that the prior art reference (1) teaches all the present claim limitations; (2) would have suggested to or provided motivation for one of ordinary skill in the art to make the claimed invention; and (3) would have provided one of ordinary skill with a reasonable expectation of success in so making. See *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988)); see also M.P.E.P. §2143. Furthermore, “[b]oth the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the applicant’s disclosure.” *In re Vaeck* at 1442.

Applicants respectfully submit that the rejection under §103 is fatally flawed because Tungare does not meet teach or suggest all of the claim elements, nor does it provide any motivation for its modification.

The Examiner declares that “Tungare teaches a glass fiber product comprising at least one glass fiber and particles adhered thereto.” Office Action at page 3. Contrary to the conclusion of the Examiner, however, Applicants respectfully submit that there is a difference between the teachings of Tungare and claims 1-52 of the presently claimed invention. In particular, the independent claim of the present invention recites that the particles adhered to the at least one glass fiber having a particle size and/or an amount that is effective to reduce its tackiness. Yet, the Examiner has failed to allege that Tungare teaches or suggests such a reduction in tackiness. In fact, Tungare teaches away from the presently claimed invention. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from

following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994) (emphasis added).

Specifically, Tungare discloses that solid particles "have the disadvantage that they may be abrasive and cause additional wear to cutting and punching tools used in the manufacture of circuit boards." See Tungare at page 3, lines 20-21. From this disclosure, one of ordinary skill in the art would have been led on a path away from using solid particles in an epoxy resin to reduce the tackiness of a glass fiber product. Accordingly, Tungare fails to teach or suggest all of the claim elements, as required to make a prima facie case of obviousness.

Moreover, the Examiner asserts only that "the glass fiber product can be yarns or fabric" and "the particles can be talc." Office Action at page 3. However, the standard in showing obviousness is not whether the references can be combined or modified -- this "does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (emphasis added) (citing *In re Mills*, 916 F.2d 680 (Fed Cir. 1990)). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") The suggestion or motivation "must be found in the prior art reference, not in the Applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Here, Tungare does not suggest the desirability of using the solid particles disclosed in Tungare in the epoxy resin to reduce the tackiness of a glass fiber product.

The Examiner also contends that “since the glass fiber product of Tungare includes particles having a size within applicants’ range and said particles are added in the same amounts contemplated by applicants, properties . . . are the same or substantially similar to those properties contemplated by applicants, in the absence of factual evidence to the contrary.” Office Action, page 6. However, the Examiner can satisfy the burden of establishing a prima facie case of obviousness “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to [modify or] combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted) (emphasis added). The Federal Circuit has reaffirmed the Examiner’s high burden to establish a prima facie case of obviousness and has emphasized the requirement of specificity. See *Kotzab*, 217 F.3d at 1370, 55 U.S.P.Q.2d, at 1317; see also *In re Sang-Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

Applicants submit that no such objective and specific evidence has been presented by the Examiner. Instead, the Examiner relies on a misapplied assertion of inherency to provide motivation for achieving the desired properties of the present invention. This is not the proper standard for a prima facie showing of obviousness. Rather, the Examiner must set forth how the broad disclosure of Tungare would have led to the specific selections needed in any attempt to arrive at the claimed invention. The Examiner has not pointed to such a “clear and particular” teaching. Broad statements are not enough. See *Kotzab*, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1317.

Accordingly, the Examiner has not satisfied the burden of proof to establish a prima facie case of obviousness with respect to the present invention. Therefore,

Applicants submit that the Examiner has failed to satisfy the burden of establishing a prima facie case of obviousness with respect to claims 1-52 of the presently claimed invention, and respectfully request that the § 103 rejection be withdrawn.

VIII. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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